

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPELLANTS: Michael MASCHKE CONFIRMATION NO. 7519
SERIAL NO.: 10/804,707 GROUP ART UNIT: 3737
FILED: March 19, 2004 EXAMINER: Elmer M. Chao
TITLE: CATHETER FOR MAGNETIC NAVIGATION

MAIL STOP APPEAL BRIEF- PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPELLANT'S REPLY BRIEF

SIR:

In accordance with the provisions of 37 C.F.R. §41.41, Appellant herewith submits his Reply Brief, in response to the Examiner's Answer dated February 7, 2008.

At page 5 of the Examiner's Answer, the Examiner cited the passage in the Lemelson reference at column 14, lines 3-7, that was extensibly discussed in Appellant's Main Brief. The Examiner then stated:

Based on the above-cited passage, Examiner contends that Lemelson's electromagnets must be driven by a current source that is capable *at the very least* of turning on some of the electromagnets within the catheter while not turning some of the electromagnets within the catheter. This would immediately satisfy the condition as recited in the claims and as argued by the Appellant with regards to the electromagnets being "independently controllable" and exhibiting "different magnetic moments". (Emphasis in original).

Appellant respectfully submits that this statement by the Examiner, as well as the subsequent statement ("Examiner strongly contends that given one electromagnet with a magnetic moment compared to another with a supposedly zero magnetic moment, the two electromagnets would definitely be considered to have

“different magnetic moments”) ignores language that was added to independent claim 1 during prosecution to explicitly preclude such an interpretation.

As stated in Appellant’s Main Brief, Appellant acknowledges that the Lemelson reference discloses at least the possibility (since the disclosure of the Lemelson reference is extremely general on this point) of activating, or not activating, individual electromagnets along the length of a catheter, in order to give the catheter a particular curvature by virtue of the interaction of the activated electromagnets with an externally-applied magnetic field. Even if the Examiner’s interpretation of the Lemelson reference is correct, this would only result in one or more electromagnets along the length of the catheter being activated, and one or more electromagnets being deactivated. Among the electromagnets that are actually activated in the Lemelson reference, however, there is no teaching that any of those activatable electromagnets has a magnetic moment that is individually controllable so that those magnetic moments will be respectively different, as required in claim 1. According to the language of claim 1 of the present application, it is completely irrelevant whether some *other* electromagnet in the Lemelson catheter may at that time be deactivated, because such as a deactivated electromagnet is then not among “said plurality of electromagnets with current supplied thereto.” As explicitly set forth in claim 1, it is the “plurality of electromagnets with current supplied thereto” that “exhibit respectively different magnetic moments.”

As extensively discussed in Appellant’s Main Brief, Appellant does not agree with the position of the Examiner that a deactivated electromagnet has somehow been “given” a magnetic moment of zero. A deactivated electromagnet is no different from any non-magnetic, non-electrically-conductive object, such as a pencil

(the example noted in Appellant's Main Brief). An object that has no magnetic moment, or for which the concept of even having a magnetic moment is meaningless, is not the same as an object that has been given a magnetic moment of zero.

In any event, the electromagnets along the catheter in the Lemelson reference that are deactivated are not "electromagnets with current supplied thereto" and thus it is completely irrelevant, with regard to the language of claim 1, as to whether those non-activated electromagnets are considered to have a magnetic moment of zero, as compared to other, activated electromagnets, which have a non-zero magnetic moment. Moreover, even among the activated electromagnets that have a non-zero magnetic moment in the Lemelson reference, there is no disclosure in that reference that any of those activated electromagnets is supplied with a different current from any of the other activated electromagnets, and therefore they all exhibit exactly the same magnetic moment, when activated. Therefore, even among the activated electromagnets in the Lemelson reference, there are no electromagnets with current supplied thereto that exhibit respectively different magnetic moments. Claim 1, moreover, requires that these respectively different magnetic moments be controllably produced, by virtue of the language in claim 1 that states that the current supply supplies respective currents to the plurality of electromagnets *to cause* said plurality of electromagnets with current supplied thereto to exhibit respectively different magnetic moments.

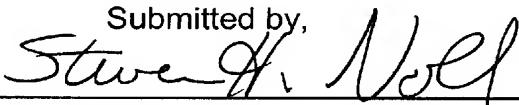
The secondary reference (Koch) does not provide any of these teachings that are absent from the Lemelson reference.

Appellant therefore respectfully submits the rejection of claims 1-4 should be reversed.

A request for an oral hearing is being filed simultaneously herewith.

The Commissioner is hereby authorized to charge any additional fees which may be required, or to credit any overpayment to account No. 501519.

Submitted by,



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